

PATENT

U.S. Patent Application No. 09/751,059

Attorney Docket No. UM-04491

REMARKS

Claims 1-70 were originally filed in the present case. Claims 1-70 were canceled and claims 71-130 were filed in a previous amendment. Claims 100, 105-109, 112, 115-120 and 122-130 were canceled, claims 131-133 were added, and claims 71, 93, 104, 110-111 and 121 were amended in a previous amendment. Claims 71, 93 and 104 are amended in the present amendment and response. Therefore, claims 71-104, 110-111, 113-114, 121 and 131-133 are currently pending.

In the Office Action dated April 1, 2005, the Examiner has withdrawn the finality of the rejection from the previous Office Action. However, the Examiner asserts a number of new rejections. The currently pending rejections are:

- 1) Claims 71-74, 78, 79, 81-83, 89, 93-95, 104, 110, 111, 113, and 114 stand rejected under 35 U.S.C. 102(e) as being anticipated by Baker *et al.*, (U.S. 6,015,832), hereinafter “Baker”;
- 2) Claims 71-74, 76-78, 80-87, 90-95, 97-99, 101-104, 113, and 114 stand rejected under 35 U.S.C. 102(b) as being anticipated by Spitzer *et al.* (U.S. 3,912,666), hereinafter “Spitzer”;
- 3) Claims 71-74, 78-87, 90, 92-95, 97-99, 101-104, 113, and 114 stand rejected under 35 U.S.C. 102(b) as being anticipated by Little-van den Hurk *et al.*, (U.S. 5,951,988), hereinafter “Little-van den Hurk”;
- 4) Claims 75 and 96 stand rejected under 35 U.S.C. 103(a) as being obvious over Baker.
- 5) Claims 121, and 131-133 stand rejected under 35 U.S.C. 103(a) as being obvious over Baker.

Each of these grounds of rejection is addressed in detail below.

I. THE CLAIMS ARE NOT ANTICIPATED

The Examiner has rejected the Claims as allegedly anticipated by several references.

The Federal Circuit has stated the relevant analysis for anticipation as follows:

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference."¹

The Applicants respectfully submits that none of the references cited by the Examiner teach each element of the Claims.

I.A. Baker Does Not Anticipate the Claims

The Examiner has rejected Claims 71-74, 78, 79, 81-83, 89, 93-95, 104, 110, 111, 113, and 114 as allegedly being anticipated by Baker. The Applicants respectfully disagree. Baker does not teach all of the elements of the claims. For example, Baker does not teach an oil-in-water emulsion comprising a halogen-containing compound. In the Office Action of April 1, 2005 the Examiner argues:

"Secondly, Baker Jr. et al. (U.S. 6,015,832) discloses a composition that comprises halogen containing compound, sodium hypochlorite, and phosphate based solvent." (Office Action of April 1, 2005, page 2).

The Examiner is in error. Baker's compositions do not contain sodium hypochlorite. To the extent that Baker mentions sodium hypochlorite (Col. 1, lines 58-64, Col 7, lines 64-67) it is to highlight that sodium hypochlorite is unsuitable for, and inferior to, the invention described in Baker:

"For example, corrosive compositions, e.g., formaldehyde and sodium hypochlorite (bleach), have been used to inactivate spores. Unfortunately, such compositions are toxic or irritating to the skin and mucus membranes. It would therefore be desirable to provide compositions and methods for inactivating bacteria including bacterial spores, which are non-toxic to skin and mucus membranes." (Baker, Col. 1, lines 58-64).

¹ *Verdegaal Bros. V. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987)

PATENT

U.S. Patent Application No. 09/751,059

Attorney Docket No. UM-04491

Hence, Baker teaches away from compositions containing sodium hypochlorite, and does not disclose a composition comprising sodium hypochlorite. Indeed, this precise distinction was correctly recognized by the Examiner in the earlier Office Action of December 28, 2004:

“While Baker (U.S. 6,015,832 discloses in column 1, lines 58-60 and column 7, lines 65-67 that sodium hypochlorite, a halogen containing compound, inactivates bacterial spores, a combination of the emulsion of Baker that does not contain halogen containing compound and hypochlorite composition, which inactivates bacterial spore, would not render the new claims obvious under 35 USC 103(a) based on In re Kerkhoven since halogen containing compounds are described by the applicants to be other than hypochlorite. Thus, applicants' argument as it relates to new claims 71 is persuasive because Baker's composition does not contain halogen-containing compound and would not even under In re Kerkhoven contain halogen-containing compound of the type applicants refer to as halogen containing compound. (Office Action of December 28, 2004, pages 3-4) (Emphasis added).

In view of the failure of Baker to teach all the elements of the claims, the Applicants request that the rejection be withdrawn.

I.B. Spitzer Does Not Anticipate the Claims

The Examiner has rejected Claims 71-74, 76-78, 80-87, 90-95, 97-99, 101-104, 113, and 114 as allegedly being anticipated by Spitzer. The Applicants respectfully disagree. Spitzer does not teach all of the elements of the claims. For example, Spitzer does not teach a phosphate based solvent. In order to further the prosecution of the present case while not acquiescing to the Examiner's argument, and retaining the right to prosecute the original claims (or similar claims) in the future, the Applicants have amended claim 104 to read “wherein said components are combined under conditions such that the said oil-in-water emulsion itself is antimicrobial”. Ample support for the amendment may be found in the Specification, pages 64-76 and 80-96 describing Examples 2-6 and 9-14. The Applicants respectfully submit that Spitzer does not teach each and every element as set forth in the claims. In view of the above, the Applicants request that this rejection be withdrawn.

PATENT

U.S. Patent Application No. 09/751,059

Attorney Docket No. UM-04491

I.C. Little-van den Hurk Does Not Anticipate the Claims

The Examiner has rejected Claims 71-74, 78-87, 90, 92-95, 97-99, 101-104, 113, and 114 as allegedly being anticipated by Little-van den Hurk. Little-van den Hurk does not teach all elements of the claims. The Examiner argues:

“However, Little-van den Hurk discloses an emulsion that contains phosphate buffered saline and phosphate buffered saline is a phosphate based solvent.”
(Office Action of April 1, 2005, page 2).

The Applicants respectfully disagree. However, in order to further the prosecution of the present case while not acquiescing to the Examiner’s argument, and retaining the right to prosecute the original claims (or similar claims) in the future, the Applicants have amended claims 71 and 93 to read “an organic phosphate based solvent”. Little-van den Hurk does not teach “an organic phosphate based solvent”. Ample support for the amendment to claims 71 and 93 may be found in the Specification, page 17:

“While the present invention is not limited to any particular mechanism, it is contemplated that the organic phosphate-based solvents employed in the emulsions serve to remove or disrupt the lipids in the membranes of the pathogens. Thus, any solvent that removes the sterols or phospholipids in the microbial membranes finds use in the emulsions of the present invention. Suitable organic solvents include, but are not limited to, organic phosphate based solvents or alcohols. In preferred embodiments, the organic phosphate based solvents include, but are not limited to, dialkyl- and trialkyl phosphates (*e.g.*, tri-n-butyl phosphate [TBP]) in any combination. A particularly preferred trialkyl phosphate in certain embodiments comprises tri-n-butyl phosphate, which is a plasticizer. Moreover, in a preferred embodiment, each alkyl group of the di- or trialkyl phosphate has from one to ten or more carbon atoms, more preferably two to eight carbon atoms. The present invention also contemplates that each alkyl group of the di- or trialkyl phosphate may or may not be identical to one another. In certain embodiments, mixtures of different dialkyl and trialkyl phosphates can be employed.” (Specification, page 17).

The Applicants respectfully submit that Little-van den Hurk does not teach each and every element as set forth in the claims. In view of the above, the Applicants request that this rejection be withdrawn.

PATENT

U.S. Patent Application No. 09/751,059

Attorney Docket No. UM-04491

II. THE CLAIMS ARE NOT OBVIOUS

The Examiner has rejected claims 75 and 96, and claims 121 and 131-133 as allegedly being obvious over Baker. The Applicants respectfully disagree. Because the independent claims are patentable over Baker, the dependent claims are also patentable over Baker. In view of the above, the Applicants request that this rejection be withdrawn.

CONCLUSION

All grounds of rejection of the Office Action of April 1, 2005 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the Applicant's claims as amended should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application the Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

Dated:

4/27/05



David A. Casimir
Registration No. 42,395

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105